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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/295,856	04/21/1999	TODD R. COLLART	IA 1506.01A US	7668

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DISCOVISION ASSOCIATES  
INTELLECTUAL PROPERTY DEVELOPMENT  
2355 MAIN STREET, SUITE 200  
IRVINE, CA 92614

EXAMINER

RODRIGUEZ, PAUL L

ART UNIT

PAPER NUMBER

2125

DATE MAILED: 05/21/2004

47

Please find below and/or attached an Office communication concerning this application or proceeding.

9

## Office Action Summary

**Application No.**

09/295,856

**Applicant(s)**

COLLART, TODD R.

**Examiner**

Paul L Rodriguez

**Art Unit**

2125

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 21,47,50-53,56-59,62-65,68-71 and 74-81 is/are pending in the application.
- 4a) Of the above claim(s) 21 and 79-81 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 47,50-53,56-59,62-65,68-71 and 74-78 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 21,47,50-53,56-59,62-65,68-71 and 74-81 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input checked="" type="checkbox"/> Other: <u>PTO-892 of paper 10</u> .  |

**DETAILED ACTION**

1. The amendment filed 3/23/04 has been received and considered. Claims 47,50-53,56-59,62-65,68-71 and 74-78 are presented for examination. Claims 21, 79-81 have been withdrawn from consideration.

***Information Disclosure Statement***

2. Applicant's representative previously contacted the Examiner in order to obtain a corrected copy of the PTO-892 submitted with the office action submitted December 2000 (paper number 10), a typographical error in a patent number has been corrected to properly identify the cited art and a copy is provided with this office action.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 50, 63, 68, 69, 71 and 74-78 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. Claim 50 recites the limitation "said optical data storage" in line 4. There is insufficient antecedent basis for this limitation in the claim. Previously recited "optical storage medium", unclear if this is the same limitation.

6. Claim 63 recites the limitation "said optical data storage" in line 4. There is insufficient antecedent basis for this limitation in the claim.

7. Claim 68 recites the limitation "said source" in line 2. There is insufficient antecedent basis for this limitation in the claim.

8. Claim 69 recites the limitation "said optical data storage" in lines 2-3. There is insufficient antecedent basis for this limitation in the claim.

9. Claim 71 recites the limitation "said optical storage medium" in lines 3-4. There is insufficient antecedent basis for this limitation in the claim.

10. Claim 71 recites the limitation "said optical data storage" in lines 11. There is insufficient antecedent basis for this limitation in the claim. Previously recited "optical medium", unclear is this is the same limitation.

11. Claim 78 recites the limitation "said logic" in line 2. There is insufficient antecedent basis for this limitation in the claim.

12. Due to the number of 35 USC § 112 second paragraph rejections, the examiner has provided a number of examples of the claim deficiencies in the above rejection(s), however, the list of rejections may not be all inclusive. Applicant should refer to these rejections as examples

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of deficiencies and should make all the necessary corrections to eliminate the 35 USC § 112 second paragraph problems and place the claims in a proper format.

***Claim Rejections - 35 USC § 102***

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

14. Claims 47,50-53,56-59,62-65,68-71, 74 and 75 are rejected under 35 U.S.C. 102(e) as being anticipated by Uranaka et al (U.S. Pat 6,470,085). The claimed invention reads on Uranaka et al as follows, where like or similar limitations have been grouped together:

Uranaka et al discloses (claim 47, 59, 71) a method for providing selective access to data on an optical storage medium (abstract, col. 1 lines 9-15, col. 4 lines 46-65), (claim 47, 59) receiving an identifier (reference number 30, col. 5 lines 58-62) incorporated on a burst cut area (BCA) (figure 2, 4) on said optical storage medium in conjunction with said data (reference numbers 21, 22, 24, figure 2, col. 4 lines 25-31, col. 5 line 58 – col. 6 line 13), (claim 47, 59) receiving pertinent user information (PK<sub>u</sub>, reference number 32, reference number 35, col. 6 line 66 – col. 7 line 9), (claim 47, 59, 71), verifying said identifier and said pertinent user information at a database (col. 7 line 54 – col. 8 line 41), (claim 47, 59, 71) tailoring a response based on a pre-defined condition (col. 8 line 42 – col. 16 line 46, figures 5-20, based on the terms of use, access is either provided or not), and (claim 47, 62), passing the response to a remote location

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(response from server to client, where client is remote from server), (claim 50, 63, 71) wherein the response is an authorization for an access to data stored on said optical data storage (reference numbers 650, 700, 800 of figures 5 with description), (claim 51) wherein said identifier incorporated on said optical storage medium is performed by a content provider (inherent, col. 1 lines 16-20, col. 5 lines 31-42), (claim 52, 64) wherein said data comprises multimedia data (col. 4 lines 46-65, CD-ROM, DVD), (claim 71) comprising receiving at a server computer (reference number 8) an identifier information read from said optical storage medium on a burst cut area (BCA) (reference number 23, 30, 35, figure 4, 5), wherein said identifier information identifies a specific instance of said optical storage medium (reference number 30), receiving at a server computer pertinent user information (col. 6 lines 50-51, 58-63), verifying said identifier information and pertinent user information using a database (figure 6a, col. 7 line 54 – col. 8 line 33), transmitting said response to a remote location (col. 7 lines 54-57, authorization sent from server to client is considered transmitting), (claim 74) wherein the identifier information is updated and stored in a BCA database (reference number 60, figure 6a) (claim 75), broadcasting one of the identifier information and the updated identifier information (col. 7 lines 54-57, information sent to and from the server and client is considered broadcasting), (claim 53) a system for providing selective access to data on an optical storage medium (figure 1), comprising a first receiver for receiving an identifier on a burst cut area (BCA) on said optical storage medium (reference number 130, col. 6 lines 51-54, 58-63), a second receiver for receiving pertinent user information (reference number 120, col. 6 lines 50-51, 58-63), said pertinent user information and said identifier being verified at a database (col. 7 line 54 – col. 8 line 41), and a response generator (server) for tailoring a response to be sent to a

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remote location (client, col. 8 line 42 – col. 16 line 46), said response being based on a pre-defined condition (col. 8 line 42 – col. 16 line 46), (claim 56) wherein said receivers are located in one location (reference number 2), (claim 57) wherein said response is passed to a remote location (response from server to client, client is remote from server), (claim 58, 70) wherein said data comprises multimedia data (col. 4 lines 46-65, inherent CD-ROM and DVD), (claim 65) a system for providing selective access to data on an optical storage medium (figure 1), comprising a receiver (reference number 130) for receiving pertinent user information (PK<sub>u</sub>, reference number 32, col. 6 line 66 – col. 7 line 9) and an identifier (reference number 30) incorporated on a burst cut area (BCA) (reference number 23) in conjunction with said data (reference numbers 21, 22, 24, figure 2), a verifier to verify said identifier at a separate database (reference number 8) and a response generator for tailoring a response to be sent to a remote location, said response being based on a pre-defined condition (col. 8 line 42 – col. 16 line 46), wherein said source is a content provider (inherent, col. 1 lines 16-20, col. 5 lines 31-42), (claim 69) wherein said response is an authorization for an access to data stored on said optical data storage (reference numbers 650, 700, 800). Examiner would like to point out that any reference to specific figures, columns and lines should not be considered limiting in any way, the entire reference is considered to provide disclosure relating to the claimed invention.

***Claim Rejections - 35 USC § 103***

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. Claims 76-78 are rejected under 35 U.S.C. 103(a) as being unpatentable over Uranaka et al (U.S. Pat 6,470,085) in view of Brindze et al (U.S. Pat 5,822,291).

Uranaka et al teaches most all of the instant invention as applied to claim 71 above. Uranaka et al fails to teach (claim 76) further comprising utilizing the identifier information to direct one of an e-commerce transaction and a "buy me" button to a retailer, (claim 77) further comprising providing a logic to control access to a web site, the logic being based on the identifier information stored on the BCA and (claim 78) wherein the logic redirects a consumer to a storefront of a retailer.

Brindze et al teaches (claim 76) further comprising utilizing the identifier information to direct one of an e-commerce transaction and a "buy me" button to a retailer (col. 8 lines 39 – col. 9 line 8, examiner considers "buy me" as anticipated by the "enhanced multimedia format" and purchasing) and (claim 78) wherein the logic redirects a consumer to a storefront of a retailer (col. 9 lines 1-5).

Uranaka et al and Brindze et al are analogous art because they are both related to the distribution of multimedia on optical storage mediums.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize the web and retailer access of Brindze et al in the system and method for providing selective access to data of Uranaka et al because Brindze et al teaches that their invention is directed to a multimedia transaction system that is particularly effective, versatile, inexpensive, and easy to use (col. 3 lines 20-22).

***Response to Arguments***

17. Applicant's arguments filed 3/23/04 have been fully considered but they are not persuasive.

Applicant argues that Uranaka et al does not disclose, suggest, or render obvious the user information to be stored in the BCA and the response is tailored based on a pre-defined condition. Examiner disagrees with applicants assertion and relies upon the description provided by Uranaka et al to address these claim limitations, Uranaka et al discloses a BCA shown in figure 2 which describes what is stored on the optical storage medium (col. 5 lines 21-42) and further defines what is stored in the BCA in figure 4 (col. 5 lines 58 – col. 6 line 5). In the detailed description of Uranaka et al, the information found in reference number 23 is information “which is determined mainly at the time of, e.g., distribution or sales”, and the descriptor 23 comprises a number of fields, one of which is PKu, a user public key reference number 32, col. 6 lines 1-2 state that that public key is the key “of the user who has legally obtained the package 20”. Therefore, Uranaka et al does clearly disclose “the user information to be stored in the BCA”. Next, regarding the “response is tailored based on a pre-defined condition”. Examiner considers the authorization response by the server to meet this limitation. When the medium is inserted, a server is accessed to determine what kind level of access a user is authorized, depending also on reference number 35, the terms of use information. These various levels of access, free of charge, usage sensitive charging and permit to play when under preset limit are all considered by the Examiner to be pre-defined tailored responses. These arguments are not persuasive and the rejection is maintained.

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Regarding the rejections under 35 USC 103, applicant argues that Oshima et al and Brindze et al do not disclose the user information stored in the BCA and the response is tailored based on a pre-defined condition. As pointed out above, it is the Examiners position that the argued limitations are both clearly taught by Uranaka et al. Nowhere in this or the previous office action rejections where Oshima et al and Brindze et al relied upon to teach these specific argued limitations. Therefore the arguments are not persuasive and the rejections are maintained.

### ***Conclusion***

18. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Getsin et al (U.S. Pub 2004/0024889) – teaches DVD with BCA and accessing information at a client.

Getsin et al (U.S. Pat 6,529,949) – system and method for accessing information on an optical medium.

19. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

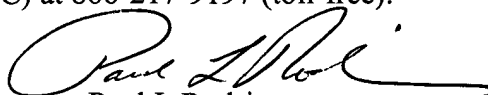
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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul L Rodriguez whose telephone number is (703) 305-7399. The examiner can normally be reached on 6:00 - 4:30 T-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Leo P Picard can be reached on (703) 308-0538. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Paul L Rodriguez  
Examiner  
Art Unit 2125

PLR  
5/18/04